

### **REMARKS**

This is in response to the Office Action mailed on January 10, 2005, and the references cited therewith.

Claims 1, 6, 32, 63, 67 and 69 are amended; claims 4, 35, 66, and 70 are cancelled; as a result, claims 1-3, 5-34, 36-65, and 67-69 are now pending in this application.

### **Drawings**

The drawings were rejected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "N00" found on page 30 of the specification. Responsive to the above rejection the specification was amended to substitute "2400" for "N00." Applicants submit that support for this amendment may be found in the first sentence of the first paragraph on page 29, "Figure 24 is a diagrammatic representation of a machine in the form of computer system 2400..." and throughout pages 30 and 31 of the specification. Applicants further submit that new matter has not been added to the application and respectfully request the Examiner to enter this amendment.

### **§112 Rejection of the Claims**

Claims 6, 10, 37, and 41 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, claims 6, 10, 37, and 41 were rejected for insufficient antecedent basis and claims 69 and 70 were rejected for reciting "The method" instead of "The machine readable medium." Responsive to the above rejection the claims 1 and 32 were amended to correct the insufficient antecedent basis, the claim 69 was amended to include the phrase "The machine readable medium" instead of "The method" and the claim 70 was cancelled.

### **§103 Rejection of the Claims**

Claims 1-4, 6, 7 10-18, 22, 27, 28, 32-35, 37, 38, 41-49, 53, 58, 59, and 63-70 were rejected under 35 USC § 103(a) as being unpatentable over Mundy et al. (U.S. 6,317,792; hereinafter Mundy) in view of Monachello et al. (U.S. 6,748,439; hereinafter Monachello).

Applicants respectfully submit that claims 1-4, 6, 7 10-18, 22, 27, 28, 32-35, 37, 38, 41-49, 53, 58, 59, and 63-70 should not be rejected under 35 U.S.C. § 103(a) for the reason that prior art references when combined do not teach or suggest all of the claim limitations of the independent claims of the present application.

To establish a **prima facie** case of **obviousness**, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Claim 1 includes the following limitations:

receiving, at a customization system, the customization information pertaining to the customized network connection application .....from a customer of the customization system

distributing the customized network connection application to a plurality of end-users associated with the customer

The Office Action contends that the above limitation is not explicitly taught by Mundy but anticipated by the following disclosure in Monachello:

Individual service selection designates one or more NSP's for all users in the group.  
Monachello, Col. 3, line 17-18.

The above quote from Monachello describes service selection. Service selection is described as including one or more Network Service Providers for all users in a group.

Claim 1 requires distributing a customized network connection application to end-users associated with a customer that provides customization information pertaining to the customized network connection application. For example, in one embodiment a customer may add points of

presence (POPs) to a phonebook that may be included in a customized network application that is distributed to end-users associated with the customer. In contrast the above quote from Monachello does not describe distributing a customized network connection application to end-users much less to end-users associated with a customer the provides customization information pertaining to the customized network connection application; but rather, service selection for a group of users. Monachello therefore cannot be said to anticipate the above quoted limitation because Monachello discloses service selection for a group of users and claim 1 requires distributing a customized network connection application to end-users associated with a customer that provides customization information pertaining to the customized network connection application.

Independent claims 32, 63 and 67 each include a limitation corresponding substantially to the above-discussed limitation of claim 1. The above remarks are accordingly also applicable to a consideration of these independent claims.

In addition, if an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 2-4, 6, 7 10-18, 22, 27, 28, 33-35, 37, 38, 41-49, 53, 58, 59, 64-66, and 68-70 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 8 and 39 were rejected under 35 USC § 103(a) as being unpatentable over Mundy and Monachello as applied respectively to claims 7 and 38 above, and in further view of Ginzboorg et al. (U.S. 6,240,091; hereinafter Ginzboorg). Claims 8 and 39 depend on independent claims 1 and 32, respectively. If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 8 and 39 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 9 and 40 were rejected under 35 USC § 103(a) as being unpatentable over Mundy, Monachello and Ginzboorg as applied respectively to claims 8 and 39 above, and in further view of 'Official Notice.' Claims 9 and 40 depend on independent claims 1 and 32 respectively. If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 9 and 40 under 35 U.S.C. § 103 is also addressed by the above remarks. Further, Applicants respectfully traverse this official notice and request the Examiner to provide a reference that describes such an element. Absent a

reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

Claims 19 and 50 were rejected under 35 USC § 103(a) as being unpatentable over Mundy and Monachello as applied respectively to claims 1 and 32 above, and in further view of Carolan et al. (U.S. 6,753,887; hereinafter Carolan). Claims 19 and 50 depend on independent claims 1 and 32 respectively. If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 19 and 50 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 20 and 51 were rejected under 35 USC § 103(a) as being unpatentable over Mundy and Monachello as applied respectively to claims 1 and 32 above, and in further view of Bleuse et al. (U.S. 6,324,579; hereinafter Bleuse). Claims 20 and 51 depend on independent claims 1 and 32, respectively. If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 20 and 51 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 21 and 52 were rejected under 35 USC § 103(a) as being unpatentable over Mundy and Monachello as applied respectively to claims 1 and 32 above, and in further view of Sitaraman et al. (U.S. 6,212,561; hereinafter Sitaraman). Claims 21 and 52 depend on independent claims 1 and 32, respectively. If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 21 and 52 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 23 and 54 were rejected under 35 USC § 103(a) as being unpatentable over Mundy and Monachello as applied respectively to claims 1 and 32 above, and in further view of Corn et al. (U.S. 5,564,017; hereinafter Corn). Claims 23 and 54 depend on independent claims 1 and 32, respectively. If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 23 and 54 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 24-26 and 55-57 were rejected under 35 USC § 103(a) as being unpatentable over Mundy and Monachello as applied respectively to claims 1 and 32 above, and in further view of MacFarlane et al. (U.S. 6,125,354; hereinafter MacFarlane). Claim sets 24-26 and 55-57 depend on independent claims 1 and 32, respectively. If an independent claim is nonobvious under 35

U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 24-26 and 55-57 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 29, 30, 60, and 61 were rejected under 35 USC § 103(a) as being unpatentable over Mundy and Monachello as applied respectively to claims 1 and 32 above, and in further view of Reeder et al. (U.S. 5,852,812; hereinafter Reeder). Claims 29, 30, 60, and 61 depend on independent claims 1, 1, 32, and 32, respectively. If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 29, 30, 60, and 61 under 35 U.S.C. § 103 is also addressed by the above remarks.

Claims 31 and 62 were rejected under 35 USC § 103(a) as being unpatentable over Mundy, Monachello and Reeder as applied respectively to claims 29 and 60 above, and in further view of 'Official Notice.' Claims 31 and 62 depend on independent claims 1 and 32, respectively. If an independent claim is nonobvious under 35 U.S.C. § 103 then, any claim depending therefrom is nonobvious and rejection of claims 31 and 62 under 35 U.S.C. § 103 is also addressed by the above remarks. Further, Applicants respectfully traverse this official notice and request the Examiner to provide a reference that describes such an element. Absent a reference, it appears that the Examiner is using personal knowledge, so the Examiner is respectfully requested to submit an affidavit as required by 37 C.F.R. § 1.104(d)(2).

In summary, Mundy in combination with Monachello in combination with Ginzboorg in combination with 'Official Notice in combination with Carolan in combination with Bleuse in combination with Sitaraman in combination with Corn in combination with MacFarlane in combination with Reeder does not teach or suggest each and every limitation of claims 1, 32, 63 and 67 as required to support rejections of the independent claims of the present application under 35 U.S.C. § 103.

#### Documents Cited but Not Relied upon for this Office Action

Applicants need not respond to the assertion of pertinence stated for the references cited but not relied upon by the Office Action since these references are not made part of the rejections in this Office Action. Applicants are expressly not admitting to this assertion and reserve the right to address the assertion should it form part of future rejections.

Conclusion

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (408) 846-8871 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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6/19/2008

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 10 day of May, 2005.

Dawn R. Shaw

Name

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Signature